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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,452	09/30/2003	William G. Kcrr	1372.79.PRC	2451
21901	7590	10/04/2004	EXAMINER	
SMITH & HOPEN PA 15950 BAY VISTA DRIVE SUITE 220 CLEARWATER, FL 33760			HAMA, JOANNE	
			ART UNIT	PAPER NUMBER
			1632	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/605,452

Applicant(s)

KERR ET AL.

Examiner

Joanne Hama, Ph.D.

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

This Application was filed September 30, 2003 and claims priority to U.S. Provisional application 60/319,583, filed September 30, 2002.

Claims 1-28 are under consideration in this Restriction Requirement.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, 20-23, drawn to a method for identifying the presence and delineation of embryonic stem cells or hematopoietic cells in a sample, classified in class 435, subclass 7.21.
- II. Claims 11-12, drawn to a method of inhibiting proliferation of stem cells, classified in class 514, subclass 2-21.
- III. Claims 13-14, drawn to a method of inhibiting differentiation of stem cells, classified in class 514, subclass 2-21.
- IV. Claims 15-17, drawn to a recombinant nucleotide promoter, classified in class 536, subclass 24.1.
- V. Claims 18, 19, 24-27, drawn to a method for inducing proliferation, by introducing an inhibitor of s-SHIP activity and wherein the proliferating stem cells are induced to differentiate, classified in class 536, subclass 24.5.
- VI. Claim 28, drawn to a method of identifying cell-specific signaling components, classified in class 530, subclass 350+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Invention I is to a method for identifying stem cells. Invention II is a method of inhibiting proliferation of stem cells. Invention I does not depend on Invention II to function and vice versa.

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Invention I is to a method for identifying stem cells. Invention III is a method of inhibiting differentiation of stem cells. Invention I does not depend on Invention III to function and vice versa.

Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Invention I is to a method for identifying stem cells. Invention IV is a recombinant nucleotide promoter. Invention I does not depend on Invention IV to function and vice versa.

Invention I and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

Invention I is to a method for identifying stem cells. Invention V is to a method for inducing proliferation and inducing differentiation in the proliferating cells. Invention I does not depend on Invention V to function and vice versa.

Invention I and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Invention I is to a method for identifying stem cells. Invention VI is to a method of identifying cell-specific signaling components. Invention I does not depend on Invention VI to function or vice versa.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Invention II is to a method of inhibiting proliferation in stem cells. Invention III is to a method of inhibiting differentiation in stem cells. Invention II does not depend on Invention III to function and vice versa.

Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Invention II is to a method of inhibiting proliferation of stem cells. Invention IV is to a recombinant nucleotide promoter. Invention II does not depend on Invention IV to function and vice versa.

Inventions II and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Invention II is to a method of inhibiting proliferation of stem cells. Invention V is to a method of inducing proliferation and to a method of inducing differentiation in proliferating cells. Invention II does not depend on Invention V to function and vice versa.

Inventions II and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Invention II is to a method of inhibiting proliferation of stem cells. Invention VI is to a method of identifying cell-specific signaling components. Invention II does not depend on Invention VI to function and vice versa.

Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Invention III is to a method of inhibiting differentiation of stem cells. Invention IV is to a recombinant nucleotide promoter. Invention III does not depend on Invention IV to function and vice versa.

Inventions III and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

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Invention III is to a method of inhibiting differentiation. Invention V is to a method of inducing proliferation and to a method of inducing differentiation in proliferating cells.

Invention III does not depend on Invention V to function and vice versa.

Inventions III and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

Invention III is to a method of inhibiting differentiation. Invention VI is to a method of identifying cell-specific signaling components. Invention III does not depend on Invention VI to function and vice versa.

Inventions IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

Invention IV is to a recombinant nucleotide promoter. Invention V is to a method of inducing proliferation and to a method of inducing differentiation in proliferating cells. Invention IV does not depend on Invention V to function and vice versa.

Inventions IV and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

Invention IV is to a recombinant nucleotide promoter. Invention VI is to a method of identifying cell-specific signaling components. Invention IV does not depend on Invention VI to function and vice versa.

Inventions V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Invention V is to a method of inducing proliferation and to a method of inducing differentiation in proliferating cells. Invention VI is to a method of identifying cell-specific signaling components. Invention V does not depend on Invention VI to function and vice versa.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, requirement to perform different searches, and their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Hama, Ph.D. whose telephone number is (571) 272-2911. The examiner can normally be reached on Monday-Friday 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, Ph.D. can be reached on (571) 272-0804. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JH

Joe Waitach
AU1632